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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91188179
Party	Plaintiff Zumba Fitness, LLC
Correspondence Address	Paul Kobak Kluger, Peretz, Kaplan & Berlin, P.L. 201 S. Biscayne Blvd. Miami, FL 33131 UNITED STATES pkobak@kpkb.com, mchesal@kpkb.com, sdossantos@kpkb.com, trademarks@kpkb.com
Submission	Motion to Amend Pleading/Amended Pleading
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Date	04/06/2009
Attachments	Zumba's Motion to Amend Notice of Opposition 2 (00000088).PDF (12 pages) (77953 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:

Application Serial No.: 77371281
Filed: January 18, 2008
Trademark: YOUZOOMBA
Applicant: A. Hamid Andalib
Published in the
 Official Gazette on: December 2, 2008

In the Matter of:

Application Serial No.: 77371229
Filed: January 14, 2008
Trademark: UZOOMBA
Applicant: A. Hamid Andalib
Published in the
 Official Gazette on: December 9, 2008

In the Matter of:

Application Serial No.: 77371247
Filed: January 14, 2008
Trademark: UZUMBA
Applicant: A. Hamid Andalib
Published in the
 Official Gazette on: December 9, 2008

In the Matter of:

Application Serial No.: 77371302
Filed: January 14, 2008
Trademark: YOUZUMBA
Applicant: A. Hamid Andalib
Published in the
 Official Gazette on: December 9, 2008

ZUMBA FITNESS, LLC,
a Florida limited liability company,

Opposer,

Opposition No. 91188179

v.

A. HAMID ANDALIB,
an individual,

Applicant.

OPPOSER’S MOTION TO AMEND ITS NOTICE OF OPPOSITION

Opposer, Zumba Fitness, LLC (“Opposer”), by and through its undersigned attorney and pursuant to TBMP § 507.02, 37 CFR § 2.107, and Rule 15, Fed. R. Civ. P., respectfully moves to amend its Notice of Opposition filed in the instant proceeding and to adopt the Amended Notice of Opposition attached hereto as Exhibit “A” as Opposer’s initial pleading in this matter. Specifically, Opposer seeks to amend its Notice of Opposition to remove two of its registrations it asserted as a basis for opposing the marks of Applicant, A. Hamid Andalib (“Applicant”), and to clarify that it is opposing Applicant’s applications on the basis of Opposer’s common law rights in its various ZUMBA marks. Opposer is also seeking to add Section 2(a) of the Lanham Act as an additional ground for opposition. The grounds for this motion are as follows:

1. On December 24, 2008, Opposer filed its Notice of Opposition in the instant proceeding and served same on Applicant. Paragraph 1 of Opposer’s Notice of Opposition asserted eight of Opposer’s registered marks as providing a basis for Opposer’s rights in its ZUMBA marks. *See* Notice of Opposition, at ¶ 1.

2. Today, Opposer filed an Application for Voluntary Surrender for Cancellation of two of the eight registrations asserted in Paragraph 1 of its Notice of

Opposition. As Opposer is voluntarily surrendering these two registrations for cancellation, they have been removed from Opposer's Amended Notice of Opposition.

3. As an additional basis for opposing the applications at issue, Opposer's Amended Notice of Opposition includes allegations that the marks covered by the applications consist of or comprise matter which may falsely suggest a connection with Opposer in violation of Section 2(a) of the Lanham Act.

4. Opposer's Amended Notice of Opposition also clarifies that Opposer is opposing Applicant's applications on the basis of Opposer's common law rights in its various ZUMBA marks.

5. It is the practice of the Patent and Trademark Office to liberally grant motions to amend. *See Cool-Ray, Inc. v. Eye Care, Inc.*, 183 U.S.P.Q. (BNA) 618, 1974 WL 20036 (Trademark Tr. & App. Bd. 1974); *TBC Brands, LLC v. Sullivan*, 2008 WL 1741919 (Trademark Tr. & App. Bd. 2008); Fed. R. Civ. P. 15(a).

6. Justice requires that Opposer be permitted to amend its Notice of Opposition. The instant opposition proceeding is in its initial stages, no discovery has been served by either party, and Applicant will not be unduly prejudiced in any way by the amendment of the Notice of Opposition.

WHEREFORE, Opposer respectfully requests that its Motion to Amend be granted and that the Amended Notice of Opposition, attached hereto as Exhibit "A," be adopted by the Board as Opposer's initial pleading in this matter.

Dated: April 6, 2009.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 6th day of April, 2009, the foregoing is being served upon the following via U.S. Mail:

Mark S. Graham, Esq.
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Knoxville, Tennessee 37901

By: /s/ Paul L. Kobak
Paul L. Kobak

Exhibit “A”

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:

Application Serial No.: 77371281
Filed: January 18, 2008
Trademark: YOUZOOMBA
Applicant: A. Hamid Andalib
Published in the
 Official Gazette on: December 2, 2008

In the Matter of:

Application Serial No.: 77371229
Filed: January 14, 2008
Trademark: UZOOMBA
Applicant: A. Hamid Andalib
Published in the
 Official Gazette on: December 9, 2008

In the Matter of:

Application Serial No.: 77371247
Filed: January 14, 2008
Trademark: UZUMBA
Applicant: A. Hamid Andalib
Published in the
 Official Gazette on: December 9, 2008

In the Matter of:

Application Serial No.: 77371302
Filed: January 14, 2008
Trademark: YOUZUMBA
Applicant: A. Hamid Andalib
Published in the
 Official Gazette on: December 9, 2008

ZUMBA FITNESS, LLC,
a Florida limited liability company,

Opposer,

Opposition No. 91188179

v.

A. HAMID ANDALIB,
an individual,



Applicant.

AMENDED NOTICE OF OPPOSITION

Opposer, Zumba Fitness, LLC, a Florida limited liability company, having its principal place of business at 3801 N. 29th Ave., Hollywood, Florida 33020 (“Opposer”), believes it will be damaged by registration of the marks shown in Trademark Application Nos. 77371281, 77371229, 77371247, and 77371302 and hereby opposes the same. The grounds for opposition are as follows:

1. Opposer is the owner of multiple U.S. trademark registrations (collectively, the “Zumba Registrations”), including:

Mark	Registration Number	Registration Date	Class / Description
ZUMBA	3244094	May 22, 2007	Education services, namely, providing classes in the field of dance and exercise. (Class 41)
ZUMBA GOLD	3296721	September 25, 2007	Education services, namely, providing classes in the field of dance and exercise. (Class 41)
ZUMBA FITNESS	3435705	May 27, 2008	Pre-recorded CDs, video tapes, laser disks and DVDs featuring physical fitness and exercise instruction; Video recordings featuring physical fitness and exercise instruction. (Class 9)

Mark	Registration Number	Registration Date	Class / Description
	3452926	June 24, 2008	Pre-recorded CDs, video tapes, laser disks and DVDs featuring physical fitness and exercise instruction; Video recordings featuring physical fitness and exercise instruction. (Class 9)
	3452872	June 24, 2008	Education services, namely, providing classes in the field of dance and exercise. (Class 41)
ZUMBATOMIC	3501639	September 16, 2008	Digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definition digital disks featuring physical fitness and dance exercise instruction for children. (Class 9)

2. Opposer uses all of the foregoing marks (collectively, the “ZUMBA Marks”) for all of the identified goods and services.

3. As the above registrations reflect, Opposer has been using the mark ZUMBA for over seven years, dating back to 2001. Opposer’s use has been valid and continuous and Opposer has not abandoned any of the ZUMBA Marks.

4. As a result of such use, Opposer has established common law rights in the ZUMBA Marks.

5. Applicant, A. Hamid Andalib (“Applicant”), is an individual having a principal place of residence 717 Creek Drive, Chattanooga, Tennessee 37415.

6. Applicant is seeking registration of the mark YOUZOOMBA in international class 41 for “Entertainment services, namely, providing music, games, movies, videos, news, e-books, and user-generated content to on-line users via the worldwide web to recipients authorized by club membership, gift cards or certificates, credit or debit card accounts, or other access criteria.”

7. Applicant is seeking registration of the marks UZOOMBA, UZUMBA, and YOUZUMBA in international class 41 for “Entertainment services, namely, providing a website where persons authorized by club membership, gift cards or certificates, credit or debit card accounts, or other access criteria may access music, games, movies, videos, news, and e-books.” Applicant’s applications for the marks YOUZOOMBA, UZOOMBA, UZUMBA, and YOUZUMBA are hereafter referred to collectively as the “the Disputed Applications.”

8. There is no priority issue in this case as Opposer has been using its various ZUMBA Marks for several years, while Applicant just filed the Disputed Applications in January 2008, and upon information and belief, is not even using its marks.

COUNT I - LANHAM ACT § 2(d)
OPPOSITION BASED ON OPPOSER’S REGISTERED MARKS

9. Opposer incorporates Paragraphs 1 through 8 as if fully set forth herein.

10. The marks covered by the Disputed Applications so resemble the ZUMBA Marks that, when used on or in connection with the goods or services of the Applicant, they are likely to cause confusion, or to cause mistake, or to deceive.

11. Because the Disputed Applications cover marks that are phonetically equivalent to the Zumba Marks and cover services related to the goods and services covered by the Zumba registrations, if Applicant is permitted to register its

YOUZOOMBA, UZOOMBA, YOUZUMBA, and UZUMBA marks for the services identified in the Disputed Applications, Opposer will be damaged because (a) confusion may result, causing consumers to purchase Applicant's services under the mistaken impression that they are Opposer's services, or are otherwise sponsored by or affiliated with Opposer; and/or (b) Applicant will be able to achieve presumptive exclusive rights to its marks, which are confusingly similar to Opposer's marks.

COUNT II - LANHAM ACT § 2(d)
OPPOSITION BASED ON OPPOSER'S MARKS PREVIOUSLY
USED IN THE UNITED STATES AND NOT ABANDONED

12. Opposer incorporates Paragraphs 1 through 8 as if fully set forth herein.

13. The marks covered by the Disputed Applications so resemble Opposers's ZUMBA Marks previously used in the United States that have not been abandoned that, when used on or in connection with the goods or services of the Applicant, they are likely to cause confusion, or to cause mistake, or to deceive.

14. Because the Disputed Applications cover marks that are phonetically equivalent to and cover services related to the goods and services related to Opposers's ZUMBA Marks previously used in the United States that have not been abandoned, if Applicant is permitted to register its YOUZOOMBA, UZOOMBA, YOUZUMBA, and UZUMBA marks for the services identified in the Disputed Applications, Opposer will be damaged because (a) confusion may result, causing consumers to purchase Applicant's services under the mistaken impression that they are Opposer's services, or are otherwise sponsored by or affiliated with Opposer; and/or (b) Applicant will be able to achieve presumptive exclusive rights to its marks, which are confusingly similar to Opposer's marks.

COUNT III - LANHAM ACT § 2(a)
OPPOSITION BASED ON FALSE
SUGGESTION OF CONNECTION WITH OPPOSER

15. Opposer incorporates Paragraphs 1 through 8 as if fully set forth herein.

16. The marks covered by the Disputed Applications consist of or comprise matter which may falsely suggest a connection with Opposer.

17. The marks identified in the Disputed Applications are the same or a close approximation of Opposer's previously used name or identity, and the marks identified in the Disputed Applications would be recognized as such.

18. Opposer is not connected with the activities performed by Applicant under the marks identified in the Disputed Applications.

19. Opposer's name or identity is of sufficient fame or reputation that when Applicant's marks are used in connection with the services described in the Disputed Applications, a connection with Opposer would be presumed. Further, any defect, objection or fault found with Applicant's services marketed under its marks would necessarily reflect upon and injure the reputation of Opposer.

20. If Applicant is granted the registrations herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its marks. Such registrations would be a source of damage and injury to Opposer.

WHEREFORE, Opposer, Zumba Fitness, LLC, respectfully requests that Application Nos. 77371281, 77371229, 77371247, and 77371302 be refused, and that the Board grant such other relief deemed just and proper.

Dated: April 6, 2009.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 6th day of April, 2009, the foregoing is being served upon the following via U.S. Mail:

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By: /s/ Paul L. Kobak
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